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10/817,564	04/01/2004	David S. Graham	GRAMP005/P06002	3810
22434	7590	01/31/2007		
BEYER WEAVER LLP P.O. BOX 70250 OAKLAND, CA 94612-0250			EXAMINER NGUYEN, JIMMY H	
			ART UNIT	PAPER NUMBER
			2629	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/31/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/817,564

Applicant(s)

GRAHAM, DAVID S.

Examiner

Jimmy H. Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 December 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-38 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-38 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 December 2006 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This Office Action is made in response to applicant's amendment filed on 12/06/2006.

Claims 1-38 are currently pending in the application. An action follows below:

Drawings

2. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the feature, "a filter device ... light" of claim 11, must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

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3. The replacement drawing was received on 12/20/2006. This drawing is not acceptable because there is nowhere in the original disclosure to teach the location of the element 25 as shown in the replacement sheet of Fig. 1. Also, note that reference character "24" has been used to designate both "X receive array" and "Processor".

Specification

4. The amendment filed 12/06/2006 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material, which is not supported by the original disclosure, is as follows: "The dark light measurement is then subtracted in the processor 24 ..." (see page 10 of the amendment).

Applicant is required to cancel the new matter in the reply to this Office Action.

Claim Objections

5. Claim 12 is objected to because of the following informalities: "follow:" in line 1 should be changed to -- following --, because of a typo. Appropriate correction is required.

6. Claim 37 is objected to because of the following informalities: "follow:" in line 1 should be changed to -- following --, because of a typo. Appropriate correction is required.

Claim Rejections - 35 USC § 112

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 1-23 and 28-38 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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As to claims 1-23, these claims recite a feature, “the data input device comprising: a lamina of light”, in lines 2-3 of independent claim 1. Since a lamina of light is only generated when the light source of the data input device operates (i.e., when the data input device does not operate, the data input device can’t comprise a lamina of light), it is considered that the invention is not clearly defined.

As to claims 28-38, these claims recite a feature, “the data input device comprising: providing a lamina of light a lamina of light”, in lines 2-3 of independent claim 28. Since a lamina of light is only generated when the light source of the data input device operates (i.e., when the data input device does not operate, the data input device can’t comprise a lamina of light) and it is not clear Applicant claims a method step or an element of the data input device, it is considered that the invention is not clearly defined.

9. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

10. Claims 8, 11 and 36 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

As to claim 8, this claim recites the feature, “...wavelength determined by one or more of the followings:... the lamina of light” (see lines 1-8), which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The disclosure, when filed, does not

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expressly disclose the lamina of light has a wavelength determined by more than one source, i.e., **two or all** sources recited in the pending claim, so as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

As to claims 11 and 36, these claims recite the feature, “a filter device configured to substrate the measured ambient light during an off cycle of the lamina of light from the measured light during an on cycle of the lamina of light”, which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The disclosure, specifically page 8, paragraph 0023, discloses “... The **filter 39** is used to filter out ambient light and allow light having a wavelength substantially matching the response profile of the photosensitive elements...” Accordingly, the original disclosure does not expressly disclose the above underlined feature recited in these pending claims, so as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

11. Claims 2 and 32 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

As to claims 2 and 32, the disclosure, when filed, does not fairly convey to one of ordinary skill in the art that applicants had in their possession the claimed limitations, “the lamina comprises one or more of ... a third axis” presently recited in lines 1-5 of these claims,

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i.e., the original disclosure does not teach the lamina comprising two or three dimensions, as claimed.

Notice to Applicants

12. Note that the cited disclosure of the cited reference(s) used in the below rejection(s) is merely at least one of plural places to support for the claimed feature. To fully understand the cited reference(s) regarding to the claimed feature(s), a read through the entire reference(s) is suggested to Applicant(s).

Claim Rejections - 35 USC § 102

13. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

14. Claims 1-3, 6-19, 21, 22, 24-32, and 35-38 are rejected under 35 U.S.C. 102(b) as being anticipated by Graham et al. (US 5,914,709), hereinafter Graham.

As to claims 1, 24 and 28, Graham discloses an apparatus and an associate method, the apparatus comprising a data input device (100/400) including elements (402, 410, 422, 404, 414, 426 (see Fig. 4) for generating a lamina of light (a grid of light, col. 4, line 62) and an optical position detection device (428, 416, 406, 412, 424, 408) (see Fig. 4) optically coupled to the lamina of light, and configured to detect data entries to the input device by determining the location of interrupts in the lamina caused when data is entered to the input device (see Figs. 1 and 4, col. 4, lines 21-34).

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As to claims 2 and 32, Graham discloses the lamina of light comprising a one-dimension plane defined by a first axis (see Fig. 1) or a two-dimensional plane defined by a first axis and a second axis (see Fig. 4).

As to claims 3 and 29, Graham discloses the apparatus comprising a display screen (108/208) (see Fig. 1, col. 4, line 31) and the lamina of light being positioned in the free space adjacent the display screen, whereby the lamina of light in the free space adjacent to the display screen is interrupted when data entries directed to the display screen are made by contacting the display screen (see Figs. 1 and 4, col. 4, lines 21-67).

As to claims 6 and 38, Graham discloses the lamina of light generated from a collimated light source (102, 104, 116/402, 410, 422) (see Figs. 1 and 4, col. 4, lines 9-46, col. 6, line 65 through col. 7, line 24).

As to claim 7, Graham discloses the lamina of light has wavelength range of 0.38 to 1.10 micrometers (see col. 7, lines 15-24).

As to claim 8, Graham discloses the lamina of light has a wavelength determined by an Light Emitting Diode (col. 7, lines 12-24).

As to claim 9, Graham discloses the lamina of light being continuously on during operation of the data input device (see col. 12, lines 23-51).

As to claims 10 and 35, Graham discloses the lamina of light is periodically cycled on and off during operation of the data input device (col. 12, lines 5-22).

As to claims 11 and 36, Graham discloses a filter device for carrying a threshold adjustment processing, which is configured to subtract the measured ambient light during an off

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cycle of the lamina of light from the measured light during an on cycle of the lamina of light (see col. 11, line 61 through col. 12, line 22).

As to claims 12 and 37, Graham discloses the display screen (208) of a personal computer (200) (see Fig. 2).

As to claim 13, Graham discloses a light source configured to generate the lamina of light, the light source positioned on one side of the lamina of light opposed to the optical position detection device located on the opposite side of the lamina of light (see Fig. 4).

As to claim 14, Graham discloses the light source generated from a light source (102) with a lens (116) (see Fig. 1) or an LED (700) with a lens (702) (see Fig. 7A).

As to claims 15-17, Graham discloses the optical position detection device comprising a light receiving array (412, 424, 416, 428) configured to detect the position of an interrupt in the lamina of light caused during a data entry to the data input device (see Fig. 4); and a processor (406, 408), coupled to the light receiving array, the processor configured to calculate the coordinate of the interrupt on the lamina of light based on the position of the interrupt as detected by the light receiving array (see col. 6, line 6 through col. 7, line 50). Graham further teaches the light receiving array (412, 424, 416, 428) being a waveguide substrate (best seen in Figs. 5 and 6A, elements 504/600), which includes a plurality of waveguide channels (604-612, see Fig. 6A), each waveguide channel (604-612) having a light input end proximate the lamina of light and an output end (see Fig. 6A); and a plurality of photosensitive elements, each photosensitive element positioned proximate the output end of one of the waveguide channels, and configured to convert a light signal received through the waveguide channel and to convert it into an electrical signal

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(see col. 7, lines 30-50). Graham teaches that the photosensitive elements can be charge coupled devices or CMOS imaging devices (see col. 7, lines 38-50).

As to claims 18 and 19, Graham discloses the light receiving array comprising lens (46, 428) including a plurality of light receiving elements configured to direct incident light from the lamina into the light input end of each of the plurality of waveguide channels respectively (see Figs. 1 and 4). Further, Graham discloses the light receiving array comprising including a plurality of light receiving elements (microlens 1112, see Fig. 11B) configured to direct incident light from the lamina into the light input end of each of the plurality of waveguide channels respectively (see Figs. 11B, col. 13, lines 24-64).

As to claims 21 and 30, Graham discloses the lamina of light defines a two-dimensional plane and the optical position detection device further comprises a first light receiving array (412, 424) positioned along one side of the lamina and a second light receiving array (416, 428) positioned along a second side of the lamina, wherein the first side and the second side are adjacent to one another (see Fig. 4).

As to claims 22 and 31, Graham discloses As shown in Fig. 4, Graham discloses a first light source (402, 410, 422) and a second light source (404, 414, 426) positioned along a third side and an fourth side of the lamina, the third side and the fourth side being adjacent to one another and being opposite of the first side and the second side respectively.

As to claims 25-27, Graham discloses all steps of these claims (see col. 6, line 25 through col. 7, line 29).

15. Claims 1-3, 6-9, 12-22, 24, 28-32, 37, and 38 are rejected under 35 U.S.C. 102(b) as being anticipated by Francis et al. (US 6,181,842 B1), hereinafter Francis.

As to claims 1, 24 and 28, Francis discloses an apparatus and an associate method, the apparatus (see Figs. 1A and 7) comprising a data input device (a digitizer 10, see Fig. 1A) including elements (13, 14) (see Fig. 1A) for generating a lamina of light (a light plane including light beams 15, see Fig. 1A) and an optical position detection device (16, 17, 19) (see Fig. 1A) optically coupled to the lamina of light, and configured to detect data entries to the input device by determining the location of interrupts in the lamina caused when data is entered to the input device (see col. 5, lines 21-38).

As to claims 2 and 32, Francis discloses the lamina of light comprising a one-dimension plane defined by a two-dimensional plane defined by a first axis and a second axis (see Fig. 1A).

As to claims 3 and 29, Francis discloses the apparatus comprising a display screen (display monitor 70M, see Fig. 7, col. 9, lines 37-52) and the lamina of light being positioned in the free space adjacent the display screen, whereby the lamina of light in the free space adjacent to the display screen is interrupted when data entries directed to the display screen are made by contacting the display screen (see Figs. 1A and 7, col. 9, lines 37-52).

As to claims 6 and 38, Francis discloses the lamina of light generated from a collimated light source (14) (see col. 9, line 55 through col. 10, line 2).

As to claim 7, Francis discloses the lamina of light has a substantially homogeneous wavelength (see col. 9, line 66 through col. 10, line 2).

As to claim 8, Francis discloses the lamina of light has a wavelength determined by an Light Emitting Diode (see col. 9, line 66 through col. 10, line 2).

As to claim 9, Francis discloses the lamina of light being continuously on during operation of the data input device (see col. 4, line 60 through col. 5, line 20).

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As to claims 12 and 37, Francis discloses the display screen (70M) of an inherent computer system.

As to claim 13, Francis discloses a light source configured to generate the lamina of light, the light source positioned on one side of the lamina of light opposed to the optical position detection device located on the opposite side of the lamina of light (see Fig. 1A).

As to claim 14, Francis discloses the light source generated from a light source (14) with a lens (28) (see Fig. 2A).

As to claims 15-17, Francis discloses the optical position detection device comprising a light receiving array (16, 19) (see Fig. 1A) configured to detect the position of an interrupt in the lamina of light caused during a data entry to the data input device (see col. 5, lines 21-38); and a processor (406, 408), coupled to the light receiving array, and an inherent processor configured to calculate the coordinate of the interrupt on the lamina of light based on the position of the interrupt as detected by the light receiving array. Francis further teaches the light receiving array (16, 19) being a waveguide substrate (see Fig. 1a), which includes a plurality of waveguide channels (see Fig. 1A), each waveguide channel having a light input end proximate the lamina of light and an output end (see Fig. 1A); and a plurality of photosensitive elements (detector cells, see col. 10, lines 15-17), each photosensitive element positioned proximate the output end of one of the waveguide channels, and configured to convert a light signal received through the waveguide channel and to convert it into an electrical signal (see col. 10, lines 3-18). Francis teaches that the photosensitive elements can be charge coupled devices CCDs or CMOS imaging devices (see col. 10, lines 15-17).

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As to claims 18 and 19, Francis discloses the light receiving array comprising lens (39) (see Fig. 3) including a plurality of light receiving elements configured to direct incident light from the lamina into the light input end of each of the plurality of waveguide channels respectively (see Figs. 1 and 4).

As to claim 20, Francis discloses the optical position detection device including a light filter (17F) to filter a selected wavelength of light from the lamina.

As to claims 21 and 30, Francis discloses the lamina of light defines a two-dimensional plane and the optical position detection device further comprises a first light receiving array (16X, 19X) positioned along one side of the lamina and a second light receiving array (16Y, 19Y) positioned along a second side of the lamina, wherein the first side and the second side are adjacent to one another (see Fig. 1A).

As to claims 22 and 31, as shown in Fig. 1A, Francis discloses a first light source (13X, 14X) and a second light source (13Y, 14Y) positioned along a third side and an fourth side of the lamina, the third side and the fourth side being adjacent to one another and being opposite of the first side and the second side respectively.

Claim Rejections - 35 USC § 103

16. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

17. Claims 4, 5, 33 and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Graham.

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As to claims 4, 5, 33 and 34, as discussed in the rejection above, Graham discloses all the claimed limitations except for Graham is silent to the light intensity being substantially uniform or substantially non-uniform, as presently claimed. However, Graham further discloses that the intensity of the light should be higher than the light activation threshold of the light detecting elements in order to determine whether the light is blocked (see col. 4, lines 16-19 and col. 11, lines 34 through col. 12, line 22). Accordingly, while Graham may not expressly disclose the light intensity being uniform or non-uniform, as presently claimed; however, one of ordinary skill in the art would have been found it obvious to utilize the lamina of light being either substantially uniform intensity or substantially non-uniform intensity, as the intensity of the light is higher than the light activation threshold of the light detecting elements in order to determine whether the light is blocked, in accordance with a particular application.

18. Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Graham, and further in view of Francis.

As to claim 20, as discussed in the rejection to claim 15 above, Graham discloses all the claimed limitations except for a light filter, as presently claimed.

However, Francis discloses a related apparatus comprising an optical position detection device (17) including a light filter (17F) to filter a selected wavelength of light from the lamina (see Fig. 1A, col. 10, line 55 through col. 11, line 38). It would have been obvious to a person of ordinary skill in the art at the time of the invention was made to provide the light filter in the optical position detection device of Graham, in view of the teaching in the Francis reference, because this would remove any unwanted wavelengths, as taught by Francis (see col. 10, lines 56-58).

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19. Claim 23 is rejected under 35 U.S.C. 103(a) as being unpatentable over Graham, and further in view of Hoshino et al. (USPUB: 2002/0030668 A1), hereinafter Hoshino.

As to claim 23, as discussed in the rejection to claim 1 above, Graham discloses all the claimed limitations except for a sleep mode element, as presently claimed.

However, Hoshino teaches an apparatus configured to enter a standby mode (i.e., the claimed sleep mode) and to reduce the quantity of light emitting device if a fingertip is not touching the fingerplate (see paragraph 0108), i.e., Hoshino teaches the feature, “a sleep mode ... of time” in lines 1-3 of claim 23. It would have been obvious to a person of ordinary skill in the art at the time of the invention was made to provide a sleep mode (or a standby mode) in the apparatus of Graham, in view of the teaching in the Hoshino reference, because this would reduce the power consumption, as taught by the Hoshino reference (see paragraph 0108).

20. Claims 4, 5, 33 and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Francis.

As to claims 4, 5, 33 and 34, as discussed in the rejection above, Francis discloses all the claimed limitations except for Graham is silent to the light intensity being substantially uniform or substantially non-uniform, as presently claimed. However, Francis’s the intensity of the light should be higher than the light activation threshold of the light detecting elements in order to determine whether the light is blocked. Accordingly, while Francis may not expressly disclose the light intensity being uniform or non-uniform, as presently claimed; however, one of ordinary skill in the art would have been found it obvious to utilize the lamina of light being either substantially uniform intensity or substantially non-uniform intensity, as the intensity of the light

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is higher than the light activation threshold of the light detecting elements in order to determine whether the light is blocked, in accordance with a particular application.

21. Claim 23 is rejected under 35 U.S.C. 103(a) as being unpatentable over Francis, and further in view of Hoshino.

As to claim 23, as discussed in the rejection to claim 1 above, Francis discloses all the claimed limitations except for a sleep mode element, as presently claimed.

However, Hoshino teaches an apparatus configured to enter a standby mode (i.e., the claimed sleep mode) and to reduce the quantity of light emitting device if a fingertip is not touching the fingerplate (see paragraph 0108), i.e., Hoshino teaches the feature, “a sleep mode ... of time” in lines 1-3 of claim 23. It would have been obvious to a person of ordinary skill in the art at the time of the invention was made to provide a sleep mode (or a standby mode) in the apparatus of Francis, in view of the teaching in the Hoshino reference, because this would reduce the power consumption, as taught by the Hoshino reference (see paragraph 0108).

Double Patenting

22. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned

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with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

23. Claims 1-3, 8, 14, 15, 28, 29 and 32 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 8-10, 13-16 and 29 of U.S. Patent No. 7,099,553 B1, hereinafter PAT553. Although the conflicting claims are not identical, they are not patentably distinct from each other because all the claimed limitations of the pending claims are recited in claims 1, 8-10 and 13-16 of the PAT553 reference, such as, an apparatus, a data input device, an optical position detection device, a light source for generating lamina of light, a display screen, a light receiving array, and a processor, as presently claimed.

Note that in order to fully respond, Applicant should either file a Terminal Disclaimer or provide an argument to the double patenting rejection.

Response to Arguments

24. Applicant's arguments filed 12/06/2006 have been fully considered but they are not persuasive.

With respect to the drawing objection for failing to show the limitation, "a filter device" of claim 11 in the Office action dated 11/13/2006, Applicant amended the specification and argued the processor 24 performing the filtering; see page 13 of the amendment. Examiner disagrees and directs the Applicant to the specification objection and the rejection under 35 USC 112, first paragraph, to claim 11 above.

With respect to the drawing objection for failing to show the limitations, "a light transmitter having space facets" and "an LED with facets" of claim 14 in the Office action dated

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11/13/2006, Applicant amended claim 14 to overcome this objection. This objection is withdrawn.

With respect to the drawing objection for failing to show the limitation, “a sleep mode element” of claim 23 in the Office action dated 11/13/2006, Applicant amended Fig. 1 to show a sleep mode element 25. In order to avoid a new matter added to the original disclosure, Examiner withdraws this objection. See the drawing disapproval above.

With respect to the claim objections to claims 8, 14, 17, 25, 26, and 29 in the Office action dated 11/13/2006, Applicant amended these claims to overcome the objections. These objections are withdrawn.

With respect to the claim objections to claims 12 and 37 in the Office action dated 11/13/2006, Applicant amended these claims only to correct one of minor informalities. See the claim objection above.

With respect to the rejection under 35 USC 112, second paragraph, to claims 1-23 and 28-38, applicant argued that a “lamina of light” is a physical element (see page 14 of the amendment). Examiner assumes that a “lamina of light” is a physical element. However, as discussed in the detailed rejection above, since a lamina of light is only generated when the light source(s) of the data input device operates, i.e., when the data input device does not operate, the data input device can’t comprise a lamina of light. For this reason, Examiner maintains these rejections.

With respect to the rejection under 35 USC 112, first paragraph, to claim 8, applicant argued that the specification, paragraph [0018] discloses the wavelength of the lamina of light of claim 8 (see page 14 of the amendment). Examiner disagrees because the paragraph [0018] does

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not teach the wavelength determined by **more than two sources** as presently claimed. In fact, the data input device of the pending application does not include all five sources, an incandescent light source, an LED, a VCSEL, and an IR wavelength generator, as claimed.

With respect to the rejection under 35 USC 112, first paragraph, to claims 11 and 36, applicant argued that the specification, paragraph [0019] discloses a processor 24 as a filter device configured to substrate ambient light from the measured light (see page 14 of the amendment). Examiner disagrees because of the specification objection above. Further, as discussed in the rejection above, the specification, specifically page 8, paragraph 0023, discloses a **filter 39** used to filter out ambient light and allow light having a wavelength substantially matching the response profile of the photosensitive elements, i.e., having a different function from a function of the claimed filtering device.

With respect to the art rejections, applicant argued that Graham and Francis both teach the use of collimated light beams to form a grid of light made up from a plurality of discrete beams of collimated light, whereas, a lamina of light is substantially continuous (see page 16, first paragraph, of the amendment). Examiner disagrees because (1) all independent claims do not recite the lamina of light being substantially continuous (note that the specification is not the measure of invention. Therefore, limitations contained therein can not be read into the claims for the purpose of avoiding the prior art. See *In re Sporek*, 55 CCPA 743, 386 F.2d 924, 155 USPQ 687 (1968)) and (2) the pending application, specifically paragraph [0016], expressly teaches that the lamina of light may be made up from a plurality of discrete light sources. For these reasons, Examiner maintains the rejections.

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With respect to the double patenting rejection, applicant argued that the claims of the present invention are directed to an input device using a lamina of light and the claims of the Graham US 7,099,553 patent are directed to the waveguides having multi-faceted surfaces used for creating a lamina of light (see page 16 of the amendment). Examiner disagrees because the claims of the Graham US 7,099,553 patent are also directed to an apparatus, i.e., an input device (see claims 1, 8-10 and 13-16 of the patent) instead of only the waveguides, as argued by the applicant.

Conclusion

25. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.


26. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jimmy H. Nguyen whose telephone number is 571-272-7675. The examiner can normally be reached on Monday - Thursday, 8:00 a.m. - 5:00 p.m..

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bipin Shalwala can be reached at 571-272-7681. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JHN
January 30, 2007



Jimmy H. Nguyen
Primary Examiner
Technology Division: 2629

Disapproved
JHN
1/24/2007

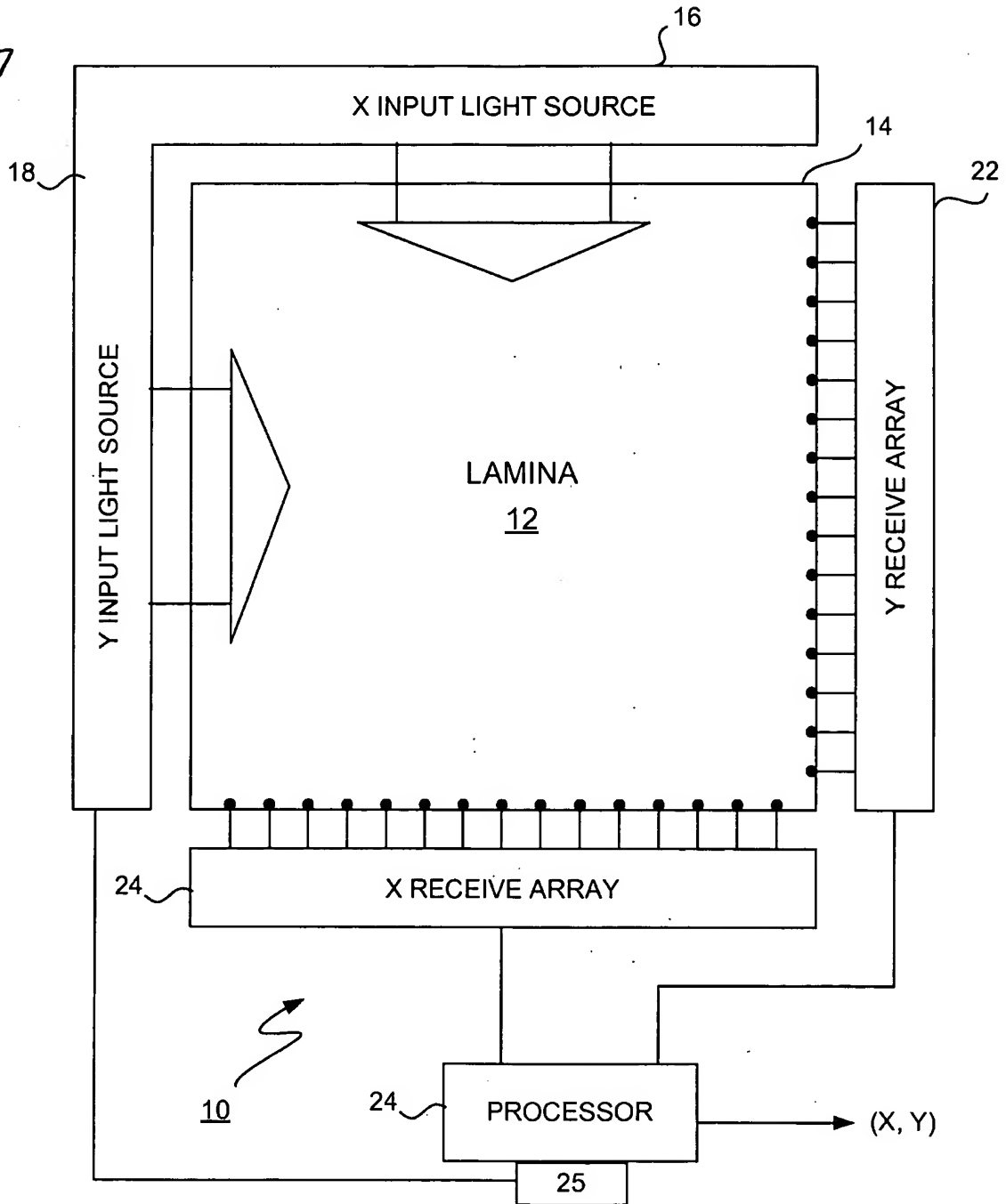


FIG. 1